

### **REMARKS**

The Office Action of April 16, 2003 has been reviewed and these remarks are responsive thereto. Claims 1-24 are pending. Claims 1, 9, 11, 19, 21 and 23 have been editorially amended. Applicants request reconsideration and allowance of the instant application. No new matter has been added.

#### **Claims 9 and 19**

Preliminary, claim 9 has been rewritten to an independent form to incorporate the features of ultimate base claim 1 as originally filed. Further, claim 19 has been rewritten to an independent form to incorporate the features of ultimate base claim 11 as originally filed. With respect to claims 9 and 19, the Office Action has relied on a proposed combination of U.S. Patent No. 5,737,599 to Rowe et al. ("Rowe") in view of U.S. Patent No. 5,832,263 to Hansen et al. ("Hansen"). Among other features, the proposed combination of Rowe and Hansen fails to describe any steps of determining a position of the object in the non-modifiable portion of the file; storing the position and the annotation separately from the non-modifiable portion of the file; wherein said determining step comprises the steps of: counting the number of bytes from the beginning of the non-modifiable portion of the file to a first object on the displayed page object; counting the number of bytes from the first object on the displayed page to the selected object; adding the number obtained from said first counting step to the number obtained from said second counting step to determine the file position of the object in said file.

Office Action points to Rowe at Col. 35, line 38-59 and col. 37, lines 66 to col. 38, line 28). It is respectfully asserted that Rowe merely describes "offset-length byte ranges" without regard to annotations with no description of determining the file position as recited in claims 9 and 19. Rowe's description of "page length in bytes" are unrelated to the "offset-length byte ranges." Further, the "page length in bytes" is discussed in Rowe with regard to so-called Hint tables with no description of determining the file position as recited in claims 9 and 19. Hansen fails to describe these features and is

deficient in this regard. In view of the foregoing, the proposed combination does not describe the inventions as recited in claims 9 and 19.

Further, it is respectfully asserted that there is no motivation to combine Rowe and Hansen. The Office Action states an alleged motivation is "for security purposes on not modifying the object." This statement however, it unsupported. In view of the foregoing, it is respectfully submitted that claim 9 and 19 are allowable. Accordingly, Applicants requests that the rejections be withdrawn.

**Claims 1-8, 10-18, and 20**

Regarding claims 1-8, 10-18, and 20, the Office Action has relied on a proposed combination of U.S. Patent No. 5,737,599 to Rowe et al. ("Rowe") in view of U.S. Patent No. 5,832,263 to Hansen et al. ("Hansen"). Regarding claims 1 and 11, it is respectfully asserted that both Rowe and Hansen fail to teach or suggest a computer-implemented method for annotating a system having a display for displaying a page having objects being intermixed with markup tags, said objects and said markup tags being stored in a non-modifiable portion, comprising the steps of: receiving a designation of an object of said objects on the displayed page; receiving an annotation; in which the annotation is modifiable; determining a position of the object in the non-modifiable portion of the file, regardless of said mark-up tags bounding said objects; storing the position and the annotation separately from the non-modifiable portion of the file. These features are at least discussed on pages 5 and 13-14 of the instant application.

It is clear that Rowe fails to describe or suggest that an "annotation" that is modifiable. Rowe describes at col. 33, lines 48-56, that the "term "annotation" will be used herein in the sense it has in the context of PDF documents: the term "annotation" includes interactive elements that are associated with a page but not properly part of the printed page itself, such as hypertext links, icons selectable to invoke a multimedia presentation, and so on, which respond to user input from devices such as a keyboard and mouse." Hence, at least on this basis Rowe fails to describe the method of claim 1 and computer readable method of claim 11.

Further, Hansen is deficient in this respect as well. Hansen fails to describe any annotations. Therefore, Hansen cannot teach or suggest that an annotation is modifiable.

Since, both references fails to teach or suggest that an annotation is modifiable, it is respectfully asserted that claims 1 and 11 are allowable at least on this basis.

It is respectfully asserted that there is no motivation to combine Rowe and Hansen. The Office Action states an alleged motivation is “for security purposes on not modifying the object.” This statement however, it not supported. Rowe is merely concerned with the display of Abode® PDF documents without regard to creating and modifying annotations. Hansen does not describe annotations. In view of the foregoing, it is respectfully asserted that claims 1 and 11 are allowable at least on this basis.

Further, Rowe and Hansen do not describe a page having objects being intermixed with markup tags, said objects and said markup tags being stored in a non-modifiable portion of a file and a step of determining the file position regardless of the mark-up tags as recited in claims 1 and 11. Hence, at least on this basis, Rowe and Hansen fail to describe the method of claim 1 and computer readable method of claim 11. Thus, dependent claims 2-8, 10-18 and 20 are allowable in light of the respective independent claims.

### **Claims 21-24**

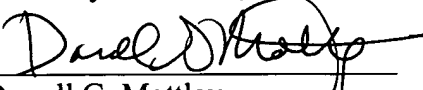
Regarding claims 21-24, the Office Action has relied on a proposed combination of U.S. Patent No. 5,737,599 to Rowe et al. (“Rowe”) in view of U.S. Patent No. 5,832,263 to Hansen et al. (“Hansen”). It is respectfully asserted that Rowe and Hansen fail to disclose the data structures as recited as claims 21 and 23. Rowe and Hansen do not describe a non-modifiable content or portion thereof including a plurality mark-up tags associated with an object for displaying a page. Hence, at least on this basis, Rowe and Hansen fail to describe the method of claim 1 and computer readable method of claim 11. Hence, at least on this basis claims 21 and 23 are allowable. Thus, dependent claims 22 and 24 are allowable in light of the respective independent claims.

### **Conclusion**

For all of the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is

desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact applicants' undersigned representative at the below-listed number. The Commissioner is authorized to charge additional fees for additional independent claims and dependent claims to our Deposit Account No. 19-0733. If any additional fees are required or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733.

Respectfully submitted,

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Dated: July 16, 2003